

Application No. 10/566,068
Amendment Dated 1/12/2009
Reply to Office Action of 09/12/2008

Remarks/Arguments:

Applicants wish to thank the Examiner for withdrawing the objection to claim 9, and the previous rejections of claims 1, 3-10, 17, and 18 under 35 USC 112, second paragraph. Applicants note they have amended claims 18, 19, 21, and 22 to add the text “or a pharmaceutically acceptable salt thereof.”

Rejection under 35 U.S.C. §103(a)

The Examiner has rejected claims 1, 3-10, 17, and 18 under 35 USC 103(a) as being allegedly unpatentable over Strobel et al (US 2003/0055093). Applicants respectfully disagree with the Examiner’s rejection.

The Examiner has argued that as Strobel teaches similar compounds where the variable B (equivalent to CH-Y in present formula (1)) can be CH₂ or CH-(C₁₋₃ alkyl) then the compounds of the present invention (which include within their scope substituted indanyl amides wherein the substituent Y may represent optionally substituted (1-4C) alkyl) are *prima facie* obvious adjacent homologues.

Applicants respectfully contend that this rejection arises from hindsight analysis based on knowledge of the present invention. In arriving at this objection, the Examiner has concentrated only on the substituent Y (while ignoring the fact that substituted alkyl is only one of the options for Y disclosed in the present invention). Applicants remind the Examiner that the claimed invention must be considered as a whole, and note that the Examiner apparently has not taken into account the fact that the compounds of the present invention also require that the indanyl amide portion of the molecule bears a specific substituent, namely an optionally substituted indole-2-yl group.

As the Examiner is well aware, the prior art (i.e. the Strobel reference) too must be considered as a whole. Although indole is included within the definition of Hetar groups allowed for in the variables recited for the group at the corresponding position in the molecule (R⁵) in the compounds of Strobel, we would argue that the average skilled man would have no reason to select B as CH-(C₁₋₃ alkyl) and R5 as indole in combination based on the disclosure of Strobel. Regarding variable B, Strobel states on page 6 (see para [0072]) that B is in particular CH₂ and so we would submit that the average skilled man would be motivated to select this option for B rather than the CH-(C₁₋₃ alkyl) option necessary for the Examiner’s homology argument to hold force. Similarly, although (as the Examiner has pointed out) Strobel provides examples of compounds in which R5 is indolyl, these are very few in number compared to the well over four hundred compounds in total exemplified

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Strobel. We would dispute, therefore, that Strobel would provide the motivation to select these particular variables in isolation even, let alone to select them in combination. In any event, the skilled man would have no reason to predict that in so doing, compounds with the presently claimed glycogen phosphorylase inhibitory activity would be obtained. The compounds of Strobel are described as being useful in upregulating endothelial nitric oxide synthase, but there is nothing in the disclosure of Strobel to suggest glycogen phosphorylase inhibitory activity.

In view of the above, applicants respectfully contend that a *prima facie* obviousness case has not been established. Accordingly, applicants respectfully request that this ground of rejection be reconsidered and withdrawn.

Rejection under 35 U.S.C. §119

The Examiner has rejected claim 19 under 35 USC 112, second paragraph for allegedly being incomplete. In response, applicants have amended claim 19 so as to make it dependent on claim 1. Accordingly, applicants respectfully request that this ground of rejection be reconsidered and withdrawn.

The above amendments have been made without prejudice to Applicants right to prosecute any cancelled subject matter in a timely filed continuation application.

Applicants believe the application is in condition for allowance, which action is respectfully requested.

A petition for a one-month extension of time is being filed herewith, the Commissioner is hereby authorized to charge any deficiency in the fees or credit any overpayment to deposit account No. 50-3231, referencing Attorney Docket No. 101160-1P US.

Respectfully submitted,

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